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Dale W. Malik

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EXAMINER

CHANG, JUNGWON

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,970	Applicant(s) MALIK, DALE W.	
	Examiner JUNGWON CHANG	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to RCE filed on 6/3/2008. Claims 1-16 are presented for examination.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/3/08 has been entered.
3. The examiner objected the specification in the previous office action dated 10/17/2007. However, the applicant has not responded to the objection. Thus, the objection to the specification is maintained. The specification is objected to because the following informalities: The cross-reference to related applications cited in page 1 of the specification has to be updated to include US Patent numbers or abandonment of applications. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coutts et al. (US 2003/0120805), hereinafter Coutts, in view of Srinivas et al, (US 7,249,161), hereinafter Srinivas.

6. As to claim 1, Coutts discloses a first communication device comprising:

means for receiving an instant messaging (IM) message (214, fig. 2) from a sender directed to a first IM address (each IM user is inherently assigned a unique instant messaging address; page 3, 0027, "the originating device allows forwarding of messages"); and

means for prompting the sender to convey the IM message to a second IM address on a second communication device (another device or next device) (214, 228, fig. 2; page 1, 0010, "would prompt the system to forward the message to another device"; page 2, 0013, "target device is not available to receive an incoming message...forwards the message to another or next device...interactive communication is conducted in real time between an originating user of the originating device and a next user of the next device"; page 3, 0027, "if the target device is not available...the originating device allows forwarding of messages);

means for conveying the IM message to a second IM address on a second communication device (each IM user is inherently assigned a unique instant messaging

address; 228, fig. 2, "message forwarded to the available next user or device").

7. Coutts does not specifically disclose means for indicating to the second communication device that the message originated from the sender. However, Srinivas discloses means for indicating to the second communication device that the message originated from the sender (col. 5, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Coutts and Srinivas because Srinivas' teaching would allow the recipient to be aware that where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

8. As to claim 2, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a first communication device comprising:

receive logic configured to receive, from a sender, an instant messaging (IM) message (214, fig. 2) directed to a first IM address (each IM user is inherently assigned a unique instant messaging address; page 3, 0027, "the originating device allows forwarding of messages"); and

prompt logic configured to the sender to convey the IM message to a second IM address on a second communication device (another device or next device) (214, 228, fig. 2; page 1, 0010, "would prompt the system to forward the message to another device"; page 2, 0013, "target device is not available to receive an incoming message...forwards the message to another or next device...interactive communication is conducted in real time between an originating user of the originating device and a

next user of the next device”; page 3, 0027, “if the target device is not available...the originating device allows forwarding of messages);

convey logic configured to convey the IM message to a second IM address on a second communication device (each IM user is inherently assigned a unique instant messaging address; 228, fig. 2, “message forwarded to the available next user or device”).

9. As to claim 3, Coutts discloses wherein the convey logic is further configured to automatically convey the IM message to the second communication device (page 1, 0001, “automatically forwarding”).

10. As to claim 4, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a communication method comprising:

receiving an instant messaging (IM) message at a first communication device, the IM message being intended for a recipient at a first IM address (204, fig. 2); and

prompting the sender to convey the IM message to a second IM address on a second communication device (another device or next device) (214, 228, fig. 2; page 1, 0010, “would prompt the system to forward the message to another device”; page 2, 0013, “target device is not available to receive an incoming message...forwards the message to another or next device...interactive communication is conducted in real time between an originating user of the originating device and a next user of the next device”; page 3, 0027, “if the target device is not available...the originating device

allows forwarding of messages);

conveying the IM message to the second IM address on the second communication device (228, fig. 2, "message forwarded to the available next user or device").

11. As to claim 5, Coutts discloses further comprising the step of: determining presence of the intended recipient at the second communication device prior to conveying the IM message to the second communication device (226, fig. 2, "next device available").

12. As to claim 11, it is rejected for the same reasons set forth in claim 1 above. In addition, Coutts discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (page 2, 0015, "memory for storage of applications and data; page 3, 0020, "client software stored by the client devices").

13. As to claim 12, it is rejected for the same reasons set forth in claim 5 above.

14. Claims 6-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. (US 6,539,421), hereinafter Appelman, in view of Srinivas et al, (US 7,249,161), hereinafter Srinivas.

15. As to claim 6, Appelman discloses a communication method comprising the steps of:

receiving an instant messaging (IM) message intended for a recipient, the recipient having IM addresses, the IM message including a designated IM address of the IM addresses for delivering the IM message (col. 3, lines 4-11, "receiving addresses of instant message recipients");

determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, "entries 502 for persons who are currently online, which is determined by checking the online status fields 506"); and

prompting the sender to convey the IM message to a second IM address on a second communications device (another device) (col. 2, lines 12-19, "instant messages can be sent to another user only when the user is presently signed on to the computer service"; col. 3, lines 40-59, "the user interface allows a user to send instant messages to exchange comments with a plurality of other users"; col. 5, line 66 – col. 6, line 7, "a subset of the group of potential recipients");

conveying the received IM message to the IM addresses at which the recipient is present (col. 6, line 16 – col. 7, line 7; col. 8, lines 10-30; col. 14, lines 45-49, "potential instant message recipient is currently online").

16. Appelman does not specifically disclose means for indicating to the second communication device that the message originated from the sender. However, Srinivas discloses means for indicating to the second communication device that the message

originated from the sender (col. 5, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Appelman and Srinivas because Srinivas' teaching would allow the recipient to aware where the message is coming from, as taught by Srinivas (col. 5, lines 15-30).

17. As to claim 7, is rejected for the same reasons set forth in claim 6 above. In addition, Appelman discloses a communication method comprising:

receiving an instant messaging (IM) message intended for a recipient, the recipient having IM addresses, the IM message including a designated IM address of the IM addresses for delivering the IM message (col. 3, lines 4-11, "receiving addresses of instant message recipients");

determining a last active time for each of the IM addresses (508, fig. 9, "time stamp"; col. 6, line 16 – col. 6, line 7, "the most recent time in its time stamp field 506");

prompting the sender to convey the IM message to a second IM address on a second communications device (another device) (col. 2, lines 12-19, "instant messages can be sent to another user only when the user is presently signed on to the computer service"; col. 3, lines 40-59, "the user interface allows a user to send instant messages to exchange comments with a plurality of other users"; col. 5, line 66 – col. 6, line 7, "a subset of the group of potential recipients");

conveying the received IM message to the IM address having a most recent last active time (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was corresponded with more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the most recent time in

its time stamp field 506")

18. As to claim 8, Appelman discloses further comprising: determining a presence of the recipient at each of the IM addresses prior to determining the last active time (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); and wherein determining the last active time comprises determining the last active time for each of the IM addresses at which the recipient is present (508, fig. 9, “time stamp”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

19. As to claim 9, Appelman discloses, wherein conveying the received IM message comprises: conveying the IM message to a most recent IM address at which the recipient is present, the most recent IM address being the IM address having the most recent last active time (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with more recently than Bartholomew”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

20. As to claim 10, Appelman discloses further comprising: determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); wherein conveying the received IM message comprises the step of conveying the received IM message to the IM address at which the recipient is

Art Unit: 2154

present (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with more recently than Bartholomew”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

21. As to claim 13, it is rejected for the same reasons set forth in claim 6 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

22. As to claim 14, it is rejected for the same reasons set forth in claim 7 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

23. As to claim 15, it is rejected for the same reasons set forth in claim 8 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

24. As to claim 16, it is rejected for the same reasons set forth in claim 9 above. In addition, Appelman discloses a computer-readable storage medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-

56).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kaminsky et al, US 2005/0055412, Shah, US 2005/0071433 disclose method and system for processing instant messenger operations dependent upon presence state information in an instant messaging system.

Response to Arguments

26. Applicant's arguments filed 6/3/08 have been fully considered but they are not persuasive:

(1) Applicant asserts that Coutts discloses "forwarding a communication message intended for one device to another device" (page 1, paragraph 0006). However, Coutts or Srinivas fails to even suggest prompting the sender to convey the IM message to a second IM address on a second communication device.

The examiner respectfully disagrees. Coutts explicitly discloses means for prompting the sender to convey the IM message to a second IM address on a second communication device (214, 228, fig. 2; page 1, 0010, "would prompt the system to forward the message to another device"; page 2, 0013, "target device is not available to receive an incoming message...forwards the message to another or next device...interactive communication is conducted in real time between an originating

user of the originating device and a next user of the next device”; page 3, 0027, “if the target device is not available...the originating device allows forwarding of messages).

(2) Appelman or Srinivas fails to even suggest prompting the sender to convey the IM message to a second IM address on a second communication device.

The examiner respectfully disagrees. Appelman explicitly discloses prompting the sender to convey the IM message to a second IM address on a second communications device (col. 2, lines 12-19, “instant messages can be sent to another user only when the user is presently signed on to the computer service”; col. 3, lines 40-59, “the user interface allows a user to send instant messages to exchange comments with a plurality of other users”; col. 5, line 66 – col. 6, line 7, “a subset of the group of potential recipients”);

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 6:30-2:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 2154

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/

Primary Examiner, Art Unit 2154

June 8, 2008